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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,177	02/20/2004	Randal G. McClure	2129	7292

23545 7590 08/27/2004

KATHLEEN M HARLESTON
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EXAMINER

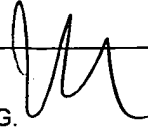
FERNSTROM, KURT

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/783,177	Applicant(s) MCCLURE, RANDAL G. 	
	Examiner Kurt Fernstrom	Art Unit 3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 21-23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5 and 7-20 is/are allowed.
- 6) ☒ Claim(s) 6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/20/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-20, drawn to an artist's color chart, classified in class 434, subclass 98.
- II. Claims 21-23, drawn to a method of using an artist's color chart, classified in class 434, subclass 84.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process can be performed using a materially different product, such as one not including a flexible, removable, disposable peel-off upper sheet portion. Also, the product as claimed could be used in a materially different process, such as providing removable indicia to identify colors.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, and vice versa, restriction for examination purposes as indicated is proper.

During a telephone conversation with Kathleen M. Harleston on August 25, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

Claim 17 is objected to because of the following informalities: The term "artist's" in the last line is missing its final "s". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites the limitation "the,,,outlined shapes" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim, as none of the claims from which claim 6 depends recites outlined shapes as part of the invention.

Allowable Subject Matter

Claims 1-5 and 7-20 are allowed.

Claim 6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose or suggest a device having all of the limitations of claims 1 and 17. In particular, there is no disclosure of an artist's color chart device comprising a board and an upper sheet portion having the claimed features. It is known for an artist to create his or her own color chart, as described by applicant in the specification. Templates having rows and columns of similarly sized and shaped apertures are known, as disclosed for example by Gorman, Shaw, Syring, Reid and Norman. However, none of these references are directed to an artist's color chart device. It is well-settled that a preamble has patentable weight to the extent that recites positive limitations to the claims; claim 1 explicitly recites that the invention is an artist's color chart device. Thus none of the aforementioned references anticipates the claim, nor is there any motivation or suggestion to combine the teachings of the references with those pertaining to artist's color chart devices to render the claimed invention obvious. As a result, claim 1, and all claims dependent therefrom, contain allowable subject matter. While claim 17 does not clearly recite an artist's color chart device ("for guiding lines in an artist's color chart" in line 1 is functional language which describes the intended purpose of the device rather than reciting further structural limitations under MPEP 2114), the limitation in claim 17 pertaining to individually removable strips

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as recited is not disclosed or suggested by the prior art. There is no motivation or suggestion in any of Gorman, Shaw, Syring, Reid and Norman to provide individual strips as claimed. As a result, claim 17, and all claims dependent therefrom, are also allowable.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gorman, Shaw, Syring, Reid, Norman, Woods, McCutcheon, Shelley and Nisbet disclose various templates. Allen Mulrane and Bowser disclose color charts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF
August 25, 2004

A handwritten signature in black ink, appearing to read 'Kurt Fernstrom', with a stylized, cursive script.

**KURT FERNSTROM
PRIMARY EXAMINER**